

REMARKS

The applicants note with appreciation the acknowledgement of the claim for priority under section 119 and the notice that all of the certified copies of the priority documents have been received.

Claims 1 - 19 are pending. The applicants respectfully request reconsideration and allowance of this application in view of the following remarks.

Claims 1 – 19 were rejected under 35 USC 102(e) as being anticipated by U.S. Patent No. 6,823,528, Yamasaki et al. (“Yamasaki”). The rejection is respectfully traversed for reasons including the following, which are provided by way of example.

Independent claim 1 recites in combination, for example, that the curable layer “has a specific heat capacity after curing of not more than 1.9 J/g·°C at 80°C.” Thereby, recorded information can be reproduced accurately even when information has been repeatedly recorded/erased. (E.g., specification page 4, lines 15 – 20.)

The office action asserts that Yamasaki anticipates the invention as claimed. To the contrary, Yamasaki fails to set forth each and every element found in the claims. “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

The office action cites Yamasaki, Example 1, and contends that Yamasaki “discloses an optical recording medium having a polycarbonate protective film adhered thereon via an adhesive formed of the same materials ... [T]he same materials are used.” Moreover, the office action argues that, because the same materials are used, that the specific heat capacity after

curing is inherent. To the contrary, the adhesive used in the Examples provided in Yamasaki is different from the materials in the examples in the present application.

For example, n-butyl acrylate and 2-hydroxyethyl acrylate were used as the monomers in Yamasaki, Example 1. On the other hand, n-butyl acrylate and acrylic acid were used as the monomers in Example 1 of the present application. Moreover, according to Example 1 of the present application, 2-methacryloxyethyl isocyanate was used to introduce methacryloyl groups to the copolymer and oligo (2-hydroxy-2-methyl-1-[4-(1-propenyl) phenyl] propanone) was used as a photopolymerization initiator, whereas these components were not used in Yamasaki. Therefore, the same materials are not used. Accordingly, the recited property is not inherent in Yamasaki.¹

Yamasaki fails to teach or suggest, for example, these features recited in independent claims 1 and 14. It is respectfully submitted therefore that claims 1 and 14 are patentable over Yamasaki.

For at least these reasons, the combination of features recited in independent claims 1 and 14, when interpreted as a whole, is submitted to patentably distinguish over the prior art. In addition, Yamasaki clearly fails to show other recited elements as well.

Claims 1 – 19 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 7 and 8 of Yamasaki. The rejection is traversed for reasons including the following, which are provided by way of example.

¹ In order to support a contention of inherency, the allegedly inherent characteristic must necessarily flow from the teachings of the reference. *In re Levy*, 17 USPQ2d 1461, 1464 (Bd Pat. App. & Inter. 1990). Therefore, if the Examiner maintains the rejection including the inherency, the Examiner is respectfully requested to provide a citation to a reference or an Examiner's affidavit. 37 CFR 1.104(d)(2); MPEP 2144.03.

Any obviousness-type double patenting rejection should make clear:

(A) The differences between the inventions defined by the conflicting claims - a claim in the patent compared to a claim in the application; and

(B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim in issue is an obvious variation of the invention defined in a claim in the patent.

Unless a claimed invention in the application is obvious over a claimed invention in the patent, no double patenting rejection of the obvious-type should be made.

The office action incorrectly fails to identify the differences between claims 7 and 8 of Yamasaki and claims 1 – 19 of the present application. Instead, the office action states that the claims “are not patentably distinct from each other because they disclose the same recording medium having a polycarbonate sheet adhered thereto via the same adhesive.” To the contrary, examples of differences include that the adhesives are not the same in the application claims 1 – 19 and Yamasaki claims 7 and 8. Examples of differences were discussed above.

Accordingly, the claims of the present application are not obvious over Yamasaki. It is respectfully requested that the examiner reconsider and withdraw the obviousness-type double patenting rejection.

With respect to the rejected dependent claims, applicant respectfully submits that these claims are allowable not only by virtue of their dependency from independent claims 1 and 14, but also because of additional features they recite in combination.

Applicants respectfully submit that, as described above, the cited prior art does not show or suggest the combination of features recited in the claims. Applicants do not concede that the

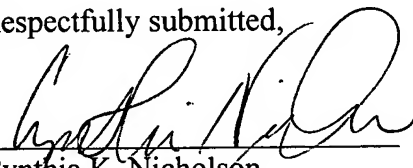
cited prior art shows any element recited in the claims. However, applicants have provided specific examples of elements in the claims that are clearly not present in the cited prior art.

Applicants strongly emphasize that one reviewing the prosecution history should not interpret any of the examples applicant has described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, for the sake of simplicity, applicants have provided examples of why the claims described above are distinguishable over the cited prior art.

In view of the foregoing, the applicants respectfully submit that this application is in condition for allowance. A timely notice to that effect is respectfully requested. If questions relating to patentability remain, the examiner is invited to contact the undersigned by telephone.

Please charge any unforeseen fees that may be due to Deposit Account No. 50-1147.

Respectfully submitted,



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